

**REMARKS**

Claims 1-38 are pending. Claims 12, 23, 24 and 29-28 have been objected to but indicated as containing allowable subject matter. Claims 1-11, 13-22 and 25-28 stand rejected. Claims 1, 5 and 7 are amended herein. New claim 39 has been added. No new matter has been introduced.

*Drawing Objections*

The office action objected to the drawings for failing to show lining 76. Attached hereto is a new drawing (FIG. 15) which schematically shows lining 76, padding 74 and exterior portion 89. No new matter has been introduced. Support for FIG. 15 can be found at least in paragraph [37] of Applicants' specification. As stated in that paragraph:

...lining 76 is a single piece and is attached to exterior portions 87, 89 at seam 78. Padding 74 is situated between lining 76 and exterior portions 87, 89, and is secured in place with adhesive. A bead is formed in padding 74 by seam 78, thereby creating collar 20.

*Claim Rejections*

The office action rejected claims 1 and 5 under 35 U.S.C. § 102(b) based on U.S. Patent 4,574,498 (Norton et al., hereinafter "Norton"). However, independent claim 1 recites features not disclosed by Norton. For example, claim 1 recites a midsole, bonded to the cleat assembly, providing cushioning in at least a midfoot region.<sup>1</sup> The office action identified Norton components 22 and 34 as corresponding to a cushioning midsole. However, Norton does not teach that these components are cushioning. Instead, Norton indicates that "base portion 22" is part of "sole 20" (col. 2, lines 41-42) and that the "control device [34] ... comprises an integral part of the sole..." Norton does not state or reasonably suggest that sole 20 is cushioning. Instead, Norton merely indicates that

...[sole 20] preferably will be formed of a material having properties including durability and flexibility among possible others to render it useful in combination with the upper in a construction of shoe [sic] for purposes discussed herein. In a preferred embodiment, the sole may be formed of nylon 12 material.

---

<sup>1</sup> Support for amendment to claim 1 can be found in Applicants' FIG. 8 and in paragraph [38] of Applicants' specification.

**Amendments to the Drawings**

The attached sheet of drawings includes a change to FIG. 14 and a new FIG. 15. Specifically, FIG. 14 has been amended to include a broken line circle corresponding to an enlarged portion shown in FIG. 15. No new matter has been added. Support for new FIG. 15 can be found in at least paragraph [37] of Applicants' specification.

Attachment:

Replacement Sheet

Col. 2, lines 36-40. Applicants observe that flexible is not the same as "cushioning," as many materials (and in particular, many solid plastics) are flexible but not cushioning. Applicants further observe that the only specific material taught by Norton (nylon 12) is not necessarily cushioning. Indeed, Norton further states that "[t]he nylon 12 material of the sole will provide that degree of strength, sturdiness, durability, support, and so forth as necessary for the sole with integral control device of the athletic shoe ..." Col. 4, lines 33-38.

Claim 1 further recites an upper lacking a full-length lasting board. Although the office action asserted that "[t]he footwear of Norton lacks a 'full-length lasting board' as claimed", no citation was provided to a specific supporting portion of Norton. The undersigned has been unable to find such support in Norton. Although Norton does refer to a "lasted upper 12" (see col. 1, lines 49-51 and col. 2, lines 21-25), this does not require the absence of a full-length lasting board. "Lasted upper" is a general term used in the art to refer to upper material pulled over (or onto) a last (or form). This can be performed in slip lasting (where no board is used), combination lasting (slip/forefoot board or strobel/forefoot board) and full board lasting.

Because Norton fails to teach an article of footwear as recited by claim 1, claim 1 is allowable. Claim 5 depends from claim 1 and is allowable for the same reasons as claim 1, as well as for additional novel features recited in claim 5. For example, Applicants have amended claim 5 to recite that the upwardly extending midsole portion includes a portion located along at least one of a medial forefoot region of the article and a lateral forefoot region of the article.

Claims 2-4 and 6-8 stand rejected under 35 U.S.C. § 103 based on Norton in combination with one of U.S. Patents 4,914,838 (Ihleberg), 6,167,640 (Schafer) or 6,018,891 (Duclos). Because these claims depend from claim 1, and because none of the secondary references teach the features not taught by Norton, claims 2-4 and 6-8 are allowable for at least the same reasons as claim 1. Moreover, Applicants have amended claim 7 to recite a lining covering the collar and extending inside a portion of a foot-receiving region of the article corresponding to a heel counter, the portion of the foot-receiving region corresponding to the heel counter being

substantially free of discontinuities.<sup>2</sup> This feature is not taught by the Norton or the secondary references.

The office action rejected claims 9-11, 13-19 and 25-28 under 35 U.S.C. § 102(e) based on U.S. Patent 6,499,235 (Lussier et al., hereinafter "Lussier"). However, Lussier fails to teach features recited by independent claim 9. Applicants observe that the office action appears to have misread claim 9. Claim 9 recites a cleat assembly which includes a lateral stiffened section located in a region of the cleat assembly generally corresponding to a midfoot portion of a lateral support bar. Claim 9 also recites a medial stiffened section located in a region of the cleat assembly generally corresponding to a midfoot portion of a medial support bar, with the medial stiffened section being stiffer than the lateral stiffened section. As is clear from the language of claim 9, it is the medial stiffened section of the cleat assembly which is stiffer than the lateral stiffened section of the cleat assembly. The office action has incorrectly read this language as referring to the medial stiffened section *of the medial support bar* and the lateral stiffened section *of the lateral support bar*. Although claim 9 states that the medial and lateral stiffened sections are located in regions that generally correspond to midfoot portions of the lateral and medial support bars, claim 9 specifically recites that the medial stiffened section of the cleat assembly is stiffer.

This aspect of claim 9 is meaningful. For example, a medial support bar in a shoe could be stiffer than a lateral support bar in that shoe, but a portion of that shoe's cleat assembly containing the medial support bar would not necessarily be stiffer than the portion of the shoe's cleat assembly containing the lateral support bar if the cleat assembly contains additional stiffening elements.

This is precisely the case in Lussier, even if one accepts that Lussier teaches a medial support bar which is stiffer than a lateral support bar.<sup>3</sup> Lussier teaches that the lateral side of the

---

<sup>2</sup> Support for this amendment can be found in Applicants' paragraph [37] and FIG. 14.

<sup>3</sup> Applicants do not accept this assertion. The office action refers to Lussier Figs. 6 and 7 and states that "[t]he medial section is thicker and therefore is naturally stiffer than the lateral stiffened section." However, proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale. See MPEP § 2125. Lussier explicitly states that its drawings are not to scale. Col. 3, lines 30-31.

Lussier cleat assembly in the midfoot region is stiffer than the medial midfoot region. This is seen in Lussier Figs. 1 and 8, which are reproduced below.

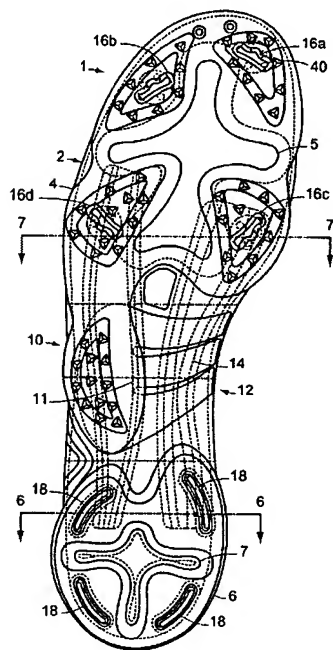


FIG. 1

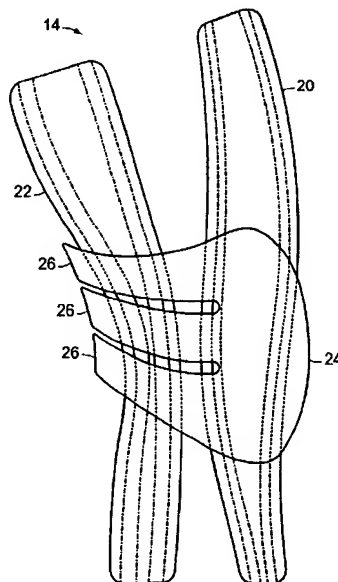
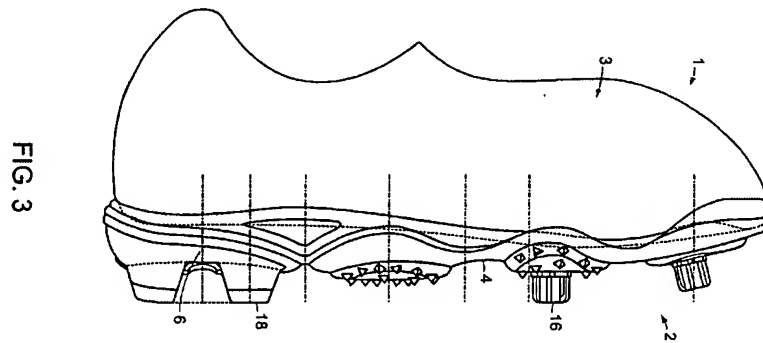


FIG. 8

Lussier Fig. 1 is a bottom view showing a sole 2 according to Lussier. Fig. 8 is a schematic view of a "stability element" 14 which connects the forefoot plate 4 and heel plate 6 of sole 2. Although Fig. 1 shows a right foot shoe and Fig. 8 appears to be for a left foot shoe, Lussier indicates that the left and right shoes are mirror images of one another. The office action states that the Lussier cleat assembly comprises sole 2, forefoot plate 4, heel plate 6, ground engaging elements 16 and 18, medial support bar 22 and lateral support bar 20. If this is so, the Lussier cleat assembly would also include "transverse element" 24. See Lussier col. 6, lines 11-13 (element 24 connects elements 20 and 22). Thus, the midfoot medial side of the Lussier cleat assembly includes longitudinal element 22 and one or more of the "fingers" 26 of transverse element 24. The midfoot lateral side of the Lussier cleat assembly includes longitudinal element

20, the solid section of transverse element 24 opposite fingers 24, and the portion of forefoot plate 4 that extends into the midfoot region.

Clearly, the lateral side of this arrangement would be stiffer. The spaces between the fingers 26 would essentially form flexure regions, while the part of element 24 attached to element 20 is solid. Moreover, and as can be seen in Lussier Fig. 3,



the portion of forefoot plate 4 extending into the midfoot is quite substantial.

Because Lussier fails to teach a feature of claim 9, claim 9 is allowable. Claims 10, 11, 13-19 and 25-28 depend from claim 9 and are thus allowable for at least the same reasons as claim 9, as well as because of additional features recited in these claims. For example, claim 11 recites a connecting matrix overlaying at least a portion of the cleat assembly base, with the lateral and medial support bars between the connecting matrix and the base. Lussier does not show any part of a cleat assembly base between the elements 20 and 22 and the shoe upper 3. In other words, Lussier does not show that the elements 20 and 22 are "between" a matrix and some element of the cleat assembly base. Claim 17 recites that the medial and lateral support bars extend to the rear of the calcaneus of a properly fitted wearer. As seen by the below comparison of Applicants' Fig. 13 (with annotation) and Lussier Fig. 2, this is not the case in Lussier.

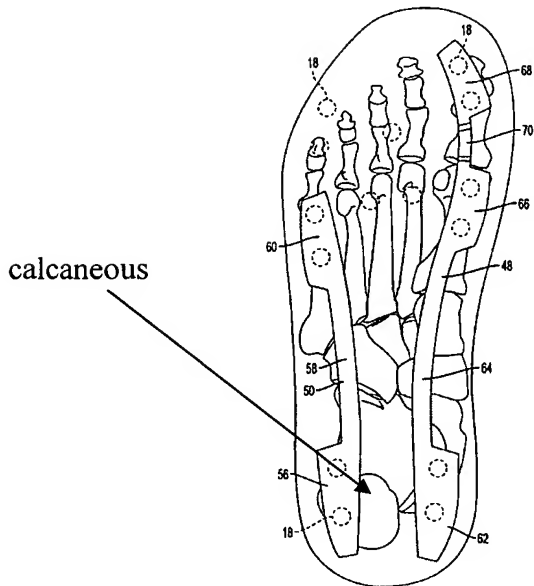


FIG. 13

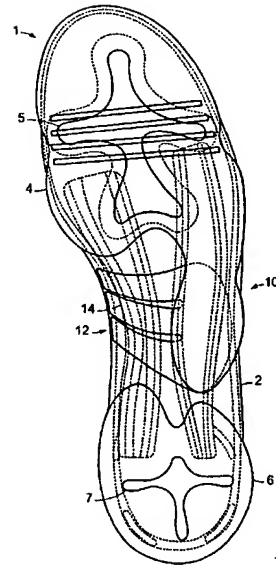


FIG. 2

Claim 25 recites that the lateral and medial support bars are stiffer than any portion of the base coupling the lateral and medial support bars. Lussier does not teach this.

Claims 20-22 stand rejected under 35 U.S.C. § 103 based on Lussier alone or in combination with one Norton or Ihleberg. Because these claims depend from claim 9, and because Ihleberg fails to teach the features of claim 9 not taught by Lussier, claims 20-22 are allowable for at least the same reasons as claim 9.

Applicants have added new claim 39 to more thoroughly claim their invention.<sup>4</sup> Because claim 39 depends from allowable claim 1, claim 39 is allowable for at least the same reasons as claim 1.

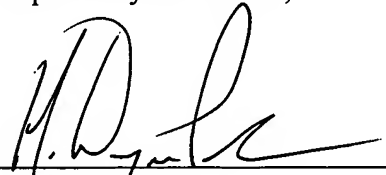
<sup>4</sup> Support for claim 39 can be found in Applicants' FIG. 8.

**CONCLUSION**

It is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully Submitted,

By:



H. Wayne Porter

Registration No. 42,084

BANNER & WITCOFF, LTD.  
1001 G Street, N.W., 11th Floor  
Washington, D.C. 20001  
(202) 824-3000

Dated: April 8, 2005